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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,120	09/11/2006	Frank Henglein	P746-4	7418
2352 7590 12/31/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
PARVINI, PEGAH				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
12/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,120

Applicant(s)

HENGLEIN ET AL.

Examiner

PEGAH PARVINI

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 17, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The rejection of claims 1-36 and 39-43 under Title 35 U.S.C. 103(a) over Schmid et al. in view of Andes et al. as generally set forth in the previous Office Action is proper and stands.

Response to Amendment

Applicants' amendment to claims 6-10, 15 and 29, filed September 17, 2008 is acknowledged. As such, the objection made to said claims are hereby withdrawn.

Response to Arguments

Applicants' arguments filed September 17, 2008 have been fully considered but they are not persuasive.

With reference to Applicants' argument drawn to the "chemical wet-oxidation" in claim 1, it is noted that said claim is a product-by-process claim; it is well settled that the limitations directed to the method for producing a claimed composition in a product claim are not considered to add patentable weight to the examination of the product claims. Further, it is well settled that if the examiner can find a product in the prior art that is the same or so similar to have been obvious, the burden can be shifted to the Applicants to demonstrate that the process for producing the composition somehow imparts a patentable distinction to the composition under examination.

It should be noted, however, that the process limitations were addressed in pages 6-8 of the previous Office Action which are incorporated herein by reference.

With reference to Applicants' argument that the process imparts significant difference in structure and appearance of the pigments and the submission of the declaration under 37 CFR 1.132 filed September 17, 2008, it is to be noted that said declaration is not sufficient to overcome the rejection of claims 1-36 and 39-43 based upon the fact that the declaration is not commensurate with the scope of the claims. The structure appearance and optical properties as has been detailed out in the declaration is not claimed in instant claims. In addition, the declaration does not outline what the specific steps of Schmid are as compared to the claimed method steps. It is to be noted that this reference details many embodiments and absence of the specific embodiments for which applicants declaration is relying upon does not sufficiently establish evidence of a structural appearance. Finally, it is to be noted that this reference uses a solvent, water, (claimed oxidizing agents), catalyst, etc. and processes this mixture at a similar temperature (reflux temperature), thus if the same materials are used at the same temperature, it is the examiners position that the same effect will be apparent and applicants have not shown sufficient evidence to the contrary.

Again, it should be noted that the process limitations claimed in the instant application have been addressed in pages 6-8 of the previous Office Action; therefore, any properties and characteristics detailed by the Applicants in the Remarks and Declaration to be associated with the product obtained from performing the process and

process steps recited in instant application is considered to follow from the product obtained by the combination of Schmid et al. in view of Andes et al.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **PEGAH PARVINI** whose telephone number is (571)272-2639. The examiner can normally be reached on **Monday to Friday 8:00am-4:30pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jerry Lorengo** can be reached on **571-272-1233**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. P./
Examiner, Art Unit 1793

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793